

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of

Metelko et al. (TI-30802)

Conf. No. 7441

Serial No. 09/802,353

Group Art Unit: 2152

Filed: March 9, 2001

Examiner: Refai

For: Wireless Data Transport of Internet Content to Display Device

**APPELLANTS' BRIEF**

Commissioner for Patents

Washington, DC 20231

Dear Sir:

Appellants respectfully present their brief in support of their appeal of the final rejection of claims in this case. The Notice of Appeal was filed on November 6, 2006, as indicated on the date of the automated receipt from the Patent and Trademark Office.

***Real Party in Interest***

The real party in interest in this application is Texas Instruments Incorporated.

***Related Appeals and Interferences***

The undersigned is aware of no related applications that are currently on appeal or in an interference that would be directly affected by, or that themselves directly affect or have a bearing on, this appeal.

### ***Status of the Claims***

Claims 1 through 24 were finally rejected in the Office Action of July 5, 2006, and are the subject of the present appeal.

### ***Status of Amendments***

No amendment was presented after the final rejection. A Request for Reconsideration was filed on October 5, 2006. No Advisory Action or other response to that Request for Reconsideration has been issued by the Examiner.

A Petition to change the name of inventor DuVal to Metelko<sup>1</sup> was recently granted by the Office of Petitions.

### ***Summary of the Claimed Subject Matter***

Independent claim 1 is directed to a display system for displaying content retrieved from the Internet. The claimed system includes an access device (11) and a display device (10).<sup>2</sup> The access device may be realized as a personal digital assistant, cell phone, or computer (portable or desktop),<sup>3</sup> while the display device may be realized a projection display or CRT display.<sup>4</sup> It is contemplated that the access device is typically not itself capable of displaying high resolution or large size images, but rather that the display device is capable of such high resolution display.<sup>5</sup> According to claim 1, the display device comprises a radio frequency receiver (21) that receives HTML commands from the access device, for example over a “Bluetooth” wireless link to the access device,<sup>6</sup> a processor (22) that interprets these HTML commands and that generates pixel data based on those commands for display,<sup>7</sup> and a display engine (26) that receives this pixel

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<sup>1</sup> As evident in the style of this Brief.

<sup>2</sup> Specification of S.N. 09/802,353, as published as U.S. Patent Application Publication No. US 2001/0054114 A1, Figure 1.

<sup>3</sup> Specification, *supra*, paragraph [0011], Figure 1.

<sup>4</sup> Specification, *supra*, paragraphs [0009] and [0010]; Figure 1.

<sup>5</sup> Specification, *supra*, paragraphs [0002] through [0005].

<sup>6</sup> Specification, *supra*, paragraph [0018]; Figure 2.

<sup>7</sup> Specification, *supra*, paragraphs [0021] through [0026]; Figure 2.

data from the processor.<sup>8</sup> It is contemplated that this display engine will typically be used to produce displayable images based on the HTML commands that are large and of high resolution, relative to the display of the access device. Using this system, the user of the access device can download video and graphics content from the Internet, and wirelessly forward that content to the display device for display.

Independent method claim 12 is directed to a method for displaying network content, such as content available on the Internet. According to the claimed method, network content in the form of HTML commands is received by way of a wireless receiver in an access device (11).<sup>9</sup> The access device then transmits the HTML commands to a display device (10), from which pixel data are generated by a processor (22) embedded in the display device.<sup>10</sup> These pixel data are then delivered to a display engine (26), and displays are generated based on that data.<sup>11</sup>

The claimed invention, in both its system and method form, provides the important benefit of enabling the display of Internet content, including high resolution video and graphics information, using a small, hand-held, computing device such as a personal digital assistant or cell phone. As discussed in the specification, these small computing devices typically have small and thus low resolution displays themselves, and are thus not suitable for displaying high quality content.<sup>12</sup> Because of this invention, however, these small computing devices can forward content, including HTML commands, to a display device that itself generates pixel data from these commands, and displays full-resolution images.<sup>13</sup> One can readily envision the benefit of this invention to salespeople and other travelers, who are enabled, by this invention, to access and display full-resolution content without themselves having to transport a projector or display device.

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<sup>8</sup> Specification, *supra*, paragraph [0028]; Figure 2.

<sup>9</sup> Specification, *supra*, paragraph [0015].

<sup>10</sup> Specification, *supra*, paragraphs [0016], [0021] through [0026].

<sup>11</sup> Specification, *supra*, paragraph [0028].

<sup>12</sup> Specification, *supra*, paragraph [0002].

<sup>13</sup> Specification, *supra*, paragraph [0003].

## ***Grounds of Rejection to Be Reviewed On Appeal***

### *The rejections of claim 1 and its dependent claims*

#### *Rejection under §102*

Claims 1 through 3, and 10 were rejected under §102(e) as anticipated by the Daniels reference<sup>14</sup>.

#### *Rejections under §103*

Claim 4 was rejected under §103 as unpatentable over the Daniels reference in view of Official Notice taken by the Examiner. Claims 5 and 11 were rejected under §103 as unpatentable over the Daniels reference in view of the Richardson et al. reference<sup>15</sup>. Claim 6 was rejected under §103 as unpatentable over the Daniels reference in view of the Lemilainen et al. reference<sup>16</sup>. Claims 7 through 9 were rejected under §103 as unpatentable over the Daniels reference in view of the MacAuley et al. reference<sup>17</sup>.

### *The rejection of claim 12 and its dependent claims*

#### *Rejection under §102*

Claims 12 through 16, 22, and 24 were rejected under §102(e) as anticipated by the Daniels reference.

#### *Rejections under §103*

Claim 17 was rejected under §103 as unpatentable over the Daniels reference in view of Official Notice taken by the Examiner. Claims 18 and 23 were rejected under §103 as unpatentable over the Daniels reference in view of the Richardson et al. reference. Claim 19 was rejected under §103 as unpatentable over the Daniels reference in view of the Lemilainen et al.

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<sup>14</sup> U.S. Patent Application Publication US 2003/0074672 A1, published April 17, 2003 based on application S.N. 10/253,012 filed December 11, 2002.

<sup>15</sup> U.S. Patent No. 6,028,764, issued February 22, 2000 to Richardson et al.

<sup>16</sup> U.S. Patent No. 6,681,239 B1, issued January 20, 2004 to Lemilainen et al.

<sup>17</sup> U.S. Patent No. 6,663,560 B2, issued December 16, 2003 to MacAuley et al.

reference. Claims 20 and 21 were rejected under §103 as unpatentable over the Daniels reference in view of the MacAuley et al. reference.

### ***Argument***

Each ground of the final rejection is a prior art rejection involving the Daniels reference. Each of the rejections under §102 is based on the conclusion that the claims are anticipated by the Daniels reference, and each of the rejections under §103 uses the Daniels reference as the primary reference.

It will be evident, from the following argument, that the basis of Appellants' appeal is that the Daniels reference is not, or has not been established as, available as prior art against any claim in this application. For the sake of clarity, and to avoid repetition, this Brief will present a single statement of arguments in support of these contentions, as applicable to all of the grounds of rejection under §102 and §103. The separate argument required by the Rules of Practice for each ground of rejection will summarily incorporate this single statement of arguments.<sup>18</sup> Appellants trust that presentation of their argument in this manner will not only satisfy the Rules of Practice, but will also reduce the burden on the Board of Appeals.

*The Daniels reference is not available as prior art against any claim in this application, under §102(e) because it is not a patent, as required by the applicable version of §102(e)*

The Daniels reference was asserted as prior art against the claims in this case by virtue of §102(e).<sup>19</sup> Appellants submit that the Daniels reference does not qualify as prior art under §102(e), and that therefore the final rejection of these claims is in error.

The Daniels reference is a United States Patent Application Publication, and is not a United States Patent.<sup>20</sup> On its face, the Daniels reference appears to claim priority, as a continuation-in-part, to prior application S.N. 09/886,695 filed June 22, 2001, which in turn

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<sup>18</sup> 37 C.F.R. §41.37 (vii).

<sup>19</sup> Office Action of July 5, 2006.

claims priority, as a continuation-in-part, to prior application S.N. 09/787,683 filed March 21, 2001. Both of these prior U.S. applications have filing dates that are after the filing date in this case.<sup>21</sup> Therefore, to the extent that the Daniels reference has an effective filing date limited to either of these two prior applications, the Daniels reference cannot be prior art to the claims in this application.

However, the Examiner asserted that the Daniels reference has an effective date, for purposes of §102(e), of a provisional application<sup>22</sup> that was filed in the United States prior to the effective filing date of this application.<sup>23</sup> The application that was published as the Daniels reference claims priority to this provisional application, through prior U.S. applications S.N. 09/886,695 and S.N. 09/787,683 mentioned above, and through a PCT International Application No. PCT/US99/21900, of which application S.N. 09/886,695 is a §371 application.<sup>24</sup> The Daniels reference can only claim priority to the provisional application through this PCT International Application, because neither of the regular U.S. applications S.N. 09/886,695 and S.N. 09/787,683 were filed within the twelve-month period following the filing of the provisional application.<sup>25</sup>

Appellants comprehend that the version of §102(e) as amended by the 2002 amendments applies to applications pending on or filed after November 29, 2000, and therefore applies to this application.<sup>26</sup> However, those 2002 amendments of §102(e) also state that patents and published applications resulting from an international application filed before November 29, 2000 shall not be effective as prior art as of the filing date of the international application, but rather are

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<sup>20</sup> Daniels, *supra*, front page.

<sup>21</sup> Not to mention the filing date of Provisional Application No. 60/191,287, filed March 21, 2000, which supports the claims in this case and to which this application claims priority under §119(e).

<sup>22</sup> U.S. Provisional Application No. 60/101,416, filed September 22, 1998.

<sup>23</sup> Office Action, *supra*, page 2.

<sup>24</sup> Daniels, *supra*, front page.

<sup>25</sup> 35 U.S.C. §119(e).

<sup>26</sup> 21ST CENTURY DEPARTMENT OF JUSTICE APPROPRIATIONS AUTHORIZATION ACT, Pub. L. 107-273, §13205 (3).

effective as prior art in accordance with §102(e) as in effect on November 28, 2000 (*i.e.*, the previous version of §102(e)).<sup>27</sup>

The Daniels reference is a published application under §122(b). Furthermore, this published application is clearly a published application that is resulting from an international application filed before November 29, 2000, namely International Application No. PCT/US99/21900.<sup>28</sup> As stated above, the only way in which the application corresponding to the Daniels reference can claim priority to the alleged provisional application is through this international application. Therefore, under the 2002 amendments to §102(e), the Daniels reference is effective as prior art under §102(e) only if it meets the terms of this prior version of §102(e).

As a reminder, the version of §102(e) in force on November 28, 2000 reads:

A person shall be entitled to a patent unless . . . (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent. . . .<sup>29</sup>

However, the Daniels reference is not a *patent*. It is a patent application published under §122(b) and, according to the Public PAIR system as March 2, 2007, the application corresponding to the Daniels reference has not yet issued as a patent.<sup>30</sup> Only *issued patents* are available as prior art under the version of §102(e) in effect on November 28, 2000. Because the Daniels reference is not an issued patent, it is therefore not a prior art reference, under the applicable version of §102(e), against the claims in this application.

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<sup>27</sup> *Id.* (“Patents resulting from an international application filed before November 29, 2000 and applications published pursuant to section 122(b) or Article 21(2) of the treaty defined in section 351(a) resulting from an international application filed before November 29, 2000 shall not be effective as prior art as of the filing date of the international application; however, such patents shall be effective as prior art in accordance with section 102(e) in effect on November 28, 2000.”)

<sup>28</sup> Assuming, *arguendo*, that the Daniels reference is entitled to priority of that international application, which has not been established.

<sup>29</sup> 35 U.S.C. §102(e), in effect on November 28, 2000.

<sup>30</sup> Indeed, as of March 2, 2007, the application has not yet even been examined.

As noted above, the Examiner asserted that the Daniels reference claims priority to a provisional U.S. application filed September 22, 1998.<sup>31</sup> This may in fact be the case.<sup>32</sup> However, the 2002 amendments to §102 (e) are clear on their face — patents and published applications “*resulting from* an international application filed before November 29, 2000 shall not be effective as prior art as of the filing date of the international application; however, such patents shall be effective as prior art in accordance with section 102(e) in effect on November 28, 2000”.<sup>33</sup> Regardless of the priority that such an international application may itself have to a previous provisional application, the statute, by its express words, still excludes the new version of §102(e) from applying to the Daniels published application.

And the policy of the Patent and Trademark Office agrees that such a provisional application does not permit the international application to avoid the effect of this prior version of §102(e):

Note that international applications which (1) were filed prior to November 29, 2000, or (2) did not designate the U.S., or (3) were not published in English under PCT Article 21(2) by WIPO, may not be used to reach back (bridge) to an earlier filing date through a priority or benefit claim for prior art purposes under 35 U.S.C. 102(e).<sup>34</sup>

This is the very situation with the Daniels reference in this case.

For this reason, Appellants submit that the Daniels reference is not prior art to any of the claims in this case, under §102(e), because it is not a patent.

*The Examiner has failed to establish that the Daniels reference has an effective date based on the provisional application to which it claims priority*

In the alternative, even assuming *arguendo* that the current version of §102(e) applies to the Daniels reference, Appellants submit that the final rejection is in error, because it fails to

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<sup>31</sup> Office Action, *supra*, page 2.

<sup>32</sup> Appellants do not admit that such priority attaches, as discussed below.

<sup>33</sup> Pub. L. 107-273, *supra* (emphasis added). Note the reference to only “patents”, and not published applications, regarding the effectiveness of the earlier version of §102(e), further indicating that published applications have no prior art effect under the earlier version of §102(e).



properly establish that the Daniels reference is entitled to the effective date of the provisional application to which it claims priority.

As discussed above, the final rejection of the claims in this case is based on the Examiner concluding that the Daniels reference is entitled to an effective date of the provisional application to which it claims priority.<sup>35</sup> Appellants submit that no findings adequate to support this conclusion were presented by the Examiner.

First, Appellants submit that the final rejection as stated does not even meet the standard asserted by the Examiner as establishing the effect of the Daniels provisional application. In making the final rejection, the Examiner asserted that “MPEP Chapter 2136.03(IV) states that the parent filing date can be used if the parent supports the claims of its child”.<sup>36</sup> Assuming *arguendo* that this is the proper legal test,<sup>37</sup> the final rejection fails to meet this test. In urging that the effective date of the Daniels reference is that of its provisional application, the Examiner merely asserts:

The provisional has been reviewed and subject matter pertaining to Daniels was found, for example, on pages 5, 13-14, 20, 24, and figs 3C, 24, 28, 29 of the provisional application.<sup>38 39</sup>

The assertion that “subject matter pertaining to Daniels” was found in the provisional application is far short of a finding that claims in the Daniels reference are supported by the provisional application. Accordingly, by the Examiner’s own standard, the final rejection does not have sufficient factual basis to establish that the Daniels reference is entitled to the effective filing date of its provisional application.

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<sup>34</sup> MPEP §2136.03(III).

<sup>35</sup> The final rejection nowhere asserts that the Daniels reference is entitled to the filing date of the PCT international application to which it claims priority. 35 U.S.C. §102(e), *as amended* November 2, 2002.

<sup>36</sup> Office Action, *supra*, page 2.

<sup>37</sup> *See infra*.

<sup>38</sup> *Id.*

<sup>39</sup> As an aside, the Examiner did not provide a copy of the Daniels provisional application to Appellants during prosecution, nor is that provisional application available via the PAIR system. Appellants have never had a fair chance, or in fact any chance, to review the Daniels provisional application and respond to the Examiner’s assertion.

Secondly, Appellants submit that, to obtain an effective date of a provisional or other priority application, a prior art reference must contain (i) at least one claim that is supported by the provisional or other priority application,<sup>40</sup> and (ii) the provisional or other priority application must itself properly support, in compliance with 35 U.S.C. §112, ¶1, the subject matter relied upon to make the rejection.<sup>41</sup>

Neither of these findings was established in rejecting the claims on appeal in this case. As discussed above, the Examiner failed to establish that any claim in the Daniels reference is supported by the provisional application to which it claims priority. Without such a finding, the Daniels provisional application bears no more relationship to the Daniels reference than does any other provisional application filed by any other applicant. Furthermore, the Examiner made no assertion that the Daniels provisional application includes the very subject matter relied upon to reject the claims. Rather, the rejection was based only on the teachings of the Daniels reference as published,<sup>42</sup> with no proof whatsoever that those alleged anticipating teachings were known by Daniels prior to Applicants' filing date.<sup>43</sup>

Accordingly, even if the Daniels reference is to be analyzed, for its effective date, under the current version of §102(e), Appellants submit that there are no findings presented by the Examiner that can possibly establish that the Daniels reference is entitled to the effective date of its provisional application.

*The argument as applied against each ground of the final rejection*

*Claims 1 through 3 and 10*

Appellants assert, for the reasons above, that the Daniels reference is not, or has not been properly established as, prior art under §102(e) against any of claims 1 through 3 and 10. For these reasons, Appellants submit that the final rejection of claims 1 through 3 and 10 under §102(e) as anticipated by the Daniels reference is in error, and should be reversed.

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<sup>40</sup> 35 U.S.C. §119(e).

<sup>41</sup> MPEP § 706.02(f)(1); MPEP §2136.03(III).

<sup>42</sup> Which has dates after the effective filing date of this application, as previously argued.

#### *Claim 4*

Appellants assert, for the reasons above, that the Daniels reference is not, or has not been properly established as, prior art under §102(e) against claim 4. For these reasons, Appellants submit that the final rejection of claim 4 under §103 as unpatentable over the Daniels reference in view of the Official Notice taken by the Examiner is in error, and should be reversed.

#### *Claims 5 and 11*

Appellants assert, for the reasons above, that the Daniels reference is not, or has not been properly established as, prior art under §102(e) against either of claims 5 and 11. For these reasons, Appellants submit that the final rejection of claims 5 and 11 under §103 as unpatentable over the Daniels reference in view of the Richardson reference is in error, and should be reversed.

#### *Claim 6*

Appellants assert, for the reasons above, that the Daniels reference is not, or has not been properly established as, prior art under §102(e) against claim 6. For these reasons, Appellants submit that the final rejection of claim 6 under §103 as unpatentable over the Daniels reference in view of the Lemilainen et al. reference is in error, and should be reversed.

#### *Claims 7 through 9*

Appellants assert, for the reasons above, that the Daniels reference is not, or has not been properly established as, prior art under §102(e) against any of claims 7 through 9. For these reasons, Appellants submit that the final rejection of claims 7 through 9 under §103 as unpatentable over the Daniels reference in view of the MacAuley et al. reference is in error, and should be reversed.

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<sup>43</sup> Much less statutorily available as prior art.

*Claims 12 through 16, 22, and 24*

Appellants assert, for the reasons above, that the Daniels reference is not, or has not been properly established as, prior art under §102(e) against any of claims 12 through 16, 22, and 24. For these reasons, Appellants submit that the final rejection of claims 12 through 16, 22, and 24 under §102(e) as anticipated by the Daniels reference is in error, and should be reversed.

*Claim 17*

Appellants assert, for the reasons above, that the Daniels reference is not, or has not been properly established as, prior art under §102(e) against claim 17. For these reasons, Appellants submit that the final rejection of claim 17 under §103 as unpatentable over the Daniels reference in view of the Official Notice taken by the Examiner is in error, and should be reversed.

*Claims 18 and 23*

Appellants assert, for the reasons above, that the Daniels reference is not, or has not been properly established as, prior art under §102(e) against either of claims 18 and 23. For these reasons, Appellants submit that the final rejection of claims 18 and 23 under §103 as unpatentable over the Daniels reference in view of the Richardson reference is in error, and should be reversed.

*Claim 19*

Appellants assert, for the reasons above, that the Daniels reference is not, or has not been properly established as, prior art under §102(e) against claim 19. For these reasons, Appellants submit that the final rejection of claim 19 under §103 as unpatentable over the Daniels reference in view of the Lemilainen et al. reference is in error, and should be reversed.

*Claims 20 and 21*

Appellants assert, for the reasons above, that the Daniels reference is not, or has not been properly established as, prior art under §102(e) against either of claims 20 and 21. For these reasons, Appellants submit that the final rejection of claims 20 and 21 under §103 as

unpatentable over the Daniels reference in view of the MacAuley et al. reference is in error, and should be reversed.

***In conclusion***

For the foregoing reasons, therefore, Appellants respectfully submit that the final rejection under §102 of claims 1 through 3, 10, 12 through 16, 22, and 24, and the final rejection under §103 of claims 4 through 9, 11, 17 through 21, and 23, are in error. Reversal of the final rejection of the claims in this case is therefore respectfully requested.

Respectfully submitted,

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***Claims appendix:***

1. A display system for displaying internet content, comprising:
  - an access device having a display unit and operable to wirelessly access content comprising HTML commands from a network and wirelessly transmit the content; and
  - a display device comprising:
    - a radio frequency receiver operable to receive the HTML commands from the access device;
    - a processor programmed to interpret the HTML commands and to generate pixel data, based on the HTML commands; and
    - a display engine operable to receive the pixel data
2. The display system of claim 1, wherein the receiver is further operable to receive data files associated with the HTML commands.
3. The display system of Claim 2, wherein data files are compressed data files; and wherein the display device further comprises:
  - a frame buffer; and
  - a digital signal processor for receiving the compressed data files from the processor, decompressing the data files, and passing the decompressed data to the frame buffer.
4. The display system of Claim 1, wherein the receiver is further operable to receive XML data representing commands for operation of the display device, and wherein the processor is further programmed to interpret the XML data.
5. The display system of Claim 1, wherein the receiver operates in accordance with bluetooth specifications.
6. The display system of Claim 1, wherein the receiver operates in accordance with IEEE specifications.

7. The display system of Claim 1, wherein the display engine has a spatial light modulator for rendering displays.

8. The display system of Claim 7, wherein the spatial light modulator is a digital micromirror device.

9. The display system of Claim 7, wherein the receiver is part of a two way RF transceiver.

10. The display system of Claim 1, wherein the processor is an embedded processor.

11. The display system for Claim 1, wherein the receiver operates in accordance with IrDA specifications.

12. A method of displaying network content, comprising the steps of:  
receiving network content, in the form of HTML commands, by means of a wireless receiver in an access device having a display unit;  
transmitting the HTML commands from the access device to a display device;  
interpreting the HTML commands;  
generating pixel data based on the HTML commands, using a processor embedded in the display device;  
delivering the pixel data from the processor to a display engine; and  
generating displays based on the pixel data.

13. The method of Claim 12, further comprising the step of receiving data files associated with the HTML commands, by means of the wireless receiver.

14. The method of Claim 13, wherein the data files are compressed data files, and further comprising the step of decompressing the data files, using a processor embedded in the display device.

15. The method of Claim 14, wherein the decompressing step is performed using an embedded digital signal processor in communication with the microprocessor.

16. The method of Claim 12, further comprising the step of receiving display operation data, by means of the wireless receiver, and of interpreting the display operation data.

17. The method of Claim 16, wherein the display operation data is in the form of XML data.

18. The method of Claim 12, wherein the step of receiving internet content is performed in accordance with bluetooth specifications.

19. The method of Claim 12, wherein the step of receiving internet content is performed in accordance with IEEE specifications.

20. The method of Claim 12, wherein the step of generating displays is performed with a spatial light modulator.

21. The method of Claim 20, wherein the spatial light modulator is a digital micromirror device.

22. The method of Claim 12, wherein the receiving steps are performed by receiving the HTML commands and display operation data from a mobile internet access device.

23. The method of Claim 12, wherein the step of receiving Internet content is performed in accordance with IrDA specifications.

24. The method of Claim 12, wherein the generating step is performed using a graphics rendering process.



***Evidence appendix:***

None.

***Related proceedings appendix:***

None.